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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,054		Peter Joseph Cassidy	080056-00020	3789

7590

11/14/2005

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EXAMINER

SHIBUYA, MARK LANCE

ART UNIT	PAPER NUMBER
1639	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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09/647,054 2/6/2007 Cassidy

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EXAMINER
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Shibuya

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Commissioner for Patents

***Response to Amendment***

The granting of applicant's petition to revive the instant application, entered 6/30/2004, is once again acknowledged.

This application is the national stage, filed pursuant to 35 USC 371, of PCT/AU99/00207, international filing date 3/24/1999. This application was restricted for lack of unity of invention in the Requirement for Restriction/Election, mailed 2/21/2003.

The examiner of record for the instant application has changed, herewith.

After consideration, the instant examiner respectfully submits that the reply filed on 05/26/2004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s), set forth below. See 37 CFR 1.111.

Applicant's response to the restriction requirement is non-responsive. Applicant has amended the claims at least twice since the Requirement for Restriction/Election, mailed 2/21/2003. Applicant latest amendment to the claims was entered 5/26/2004. Applicant stated in the Reply to Office action, entered 5/26/2004, that "[t]he intent of this amendment was to delete from the present claims the possibility of the compounds having bicyclic cores." This apparently was in effort to overcome the substance of the previous Notice of Non-Responsive Amendment, mailed 10/7/2003, written by the

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previous examiner, on the grounds that applicant had not elected a single invention form the Groups LXXI, etc, and had not provided specific definitions of Groups Q<sup>1</sup>, Q<sup>2</sup>, Q<sup>3</sup>, Q<sup>4</sup>, (and Q<sup>5</sup> if present), as required. The then examiner stated "that each of the Q groups must be specifically set forth where the specific structure (cyclic, non-cyclic) is shown and all variable groups are defined therein. This should result in a single defined cyclic core structure showing all rings therein which is further functionalized by the R and M groups." Notice, mailed 10/7/2003 at p. 2.

Applicant's current amendment to the claims, particularly base claim 113, purports to replace the Q groups and to preclude the possibility of bicyclic cores, (compare, e.g., to the D amendment, entered 7/21/2003, introducing claim 113, last line, wherein possible cyclization of Q groups is explicitly claimed to form a bicyclic ring system). However, claim 113, even as currently amended, still embraces more than a single defined cyclic core structure by reciting "Z' to be selected from the group consisting of hydrogen, methyl and *part of a cyclic amino acid sidechain joined to R<sup>1</sup>*", (emphasis added). It is observed that R<sup>1</sup> and Z' can correspond to "former" variables Q<sup>1</sup> and Q<sup>2</sup>. Furthermore, claim 114, refers to "[a] peptide mimetic as claimed in claim 113 wherein when [sic] Q<sup>1</sup> and Q<sup>2</sup> form a cyclic group Q<sup>1</sup>Q<sup>2</sup>"; and claims 116-118 refers to the possibility of forming cyclic groups. Thus, the claims appear to continue to recite Q groups that may form cyclic groups, although the relationship of these remaining Q groups to the amended structure of claim 113 is not specified, and therefore unclear. Also, the variable "R" appears in three different contexts within claim 113, including within the context of the value of the variable Z, wherein it is unclear as to whether Z

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may be connected to R as depicted in claim 113. Therefore, applicant's amendments to claims have not precluded the possibility of more than one common ring structure in claim 113, and prevent a clear understanding of what common core structures are encompassed within the claims of the invention, because the claims continue to be drawn to Q groups that are not referred to in claim 113.

In accordance with the Requirement for Restriction/Election, mailed 2/21/2003, applicant must elect an invention having a specified common core ring structure; applicant must specify the values given to the different variables that give rise to this common ring structure, particularly in regard to variables  $R^1$ , Z, and  $Z^1$ ; and applicant must indicate what claims read upon the elected invention. If other variable are capable of resulting in multiple common ring structures, applicant must elect a value for them, as well. Because applicant's amendments to the claims have obfuscated the nature of the claimed invention, the instant examiner would appreciate applicant's aid in resolving this question of what variables encompass additional common core ring structures.

In replying to the Requirement for Restriction/Election, mailed 2/21/2003, the instant examiner also requests that the applicant further elect a species from which a search is to commence, based upon the further functionalization of the elected common ring structure invention. This election of species is different from and in addition to the election of an independent invention. The species elected should be completely explicated, even as to atom and bond. Applicant should state what values for each

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variable has been elected in providing the elected species. Applicant should indicate what claims read upon the elected species. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant should indicate which are readable upon the elected species. MPEP § 809.02(a). The instant examiner makes this request in the interests of compact prosecution.

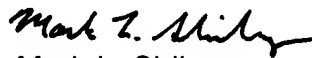
Therefore, applicants should provide the ***chemical structure of elected compounds species***, wherein each specific formula substituents of the elected species are defined either by picture, or by expressing the species in terms of the variables of the formula. Thus, applicant should provide, for search purposes, a *first* chemical structure of a particular elected distinct species claimed and a *second* core ring structure for the particular elected Invention of the Group LXXI, etc., as required in the Requirement for Restriction/Election. The provided chemical structure of the elected species must depict a single molecule, from which a search is to commence.

Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mark L. Shibuya  
Examiner  
Art Unit 1639

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